

Application No. 10/806,070
Filed: March 22, 2004
TC Art Unit: 3644
Confirmation No.: 1513

REMARKS

In the most recent Office Action, claims 1-6, 12, 15, 17-19 and 21-41 were examined. Claims 23-26 and 31-41 are withdrawn from consideration. Claims 1-6, 12, 15, 17-19, 21-22 and 27-30 are rejected.

In response, claims 1-2 are amended. No new matter is added.

Applicant thanks the Examiner for the thorough search and consideration of the invention recited in the present claims of the application, and responds to the comments in the Office Action as follows.

Election/Restrictions

The Office Action states that while Applicant elects the claims of invention 1 with traverse, the election is treated as being made without traverse. In particular, the Office Action states that Applicant presented no reasons explaining why the restriction requirement was improper.

In response, Applicant notes that the reply filed on 21 October, 2005 states that examination of all of the claims is not seen as imposing and undue burden on the Examiner. This assertion is made in response to the restriction requirement to indicate that there is no serious burden on the Examiner if restriction is

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not required. See M.P.E.P. § 808.01(a) ¶1. The Examiner has not explained why there would be a serious burden on the Examiner if restriction is not required. M.P.E.P. § 808.02 ¶2. Accordingly, Applicant respectfully requests that the election of invention 1 directed to claims 1-6, 12, 15, 17-19, 21-37 be treated as an election with traverse. In addition, Applicant respectfully requests that the restriction requirement be reconsidered and withdrawn for the reasons cited above.

The Office Action also states that claims 23-26 and 31-37 have been withdrawn from further consideration as being drawn to a non-elected invention. In particular, the Office Action states that claims 23-26 and 31-37 are not directed to the elected species 2, a flower box assembly as shown in Figures 12-16. In response, Applicant first notes that the application is entitled to a reasonable number of species and is not limited to a single embodiment depicted in the drawings of the invention. In addition, Applicant notes that claims 23-25, 27 and 31-32 are directed to the indicated species 2, a flower box assembly as shown in Figures 12-16. Accordingly, Applicant respectfully requests rejoinder of those claims and withdrawal of the restriction requirement.

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Applicant further respectfully submits that claims 26 and 33-37 should not be withdrawn from consideration in the present examination. As noted above, Applicant is permitted a reasonable number of species and features related to those species. It is believed that claim 1 is generic and that the limited number of species do not represent an undue burden on the examination process for the Examiner, as discussed above.

In support of withdrawal of the restriction requirement, Applicant submits that the specification refers to the embodiments illustrated in Figures 1-16 with substantially similar terminology, indicating that the specific embodiments shown in the drawings are variations of a core concept. The concept of the invention is illustrated in the claims of the invention believed to be generic, including claims 1, 3, -6, 12, 17-19, 22-25 and 27-32. Accordingly, Applicant respectfully submits that a search conducted for the elected claims should return all the prior art that is applicable to the withdrawn claims directed to an additional embodiment. Applicant therefore respectfully requests that the restriction requirement be reconsidered and withdrawn.

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Drawings

The drawings are objected to for failing to include reference signs indicated in the description. Applicant submits with this response corrected drawing sheets as replacement sheets for consideration by the Examiner. Entry of the replacement sheets and withdrawal of the objection to the drawings is respectfully requested.

Specification

The Office Action states that the specification should include particular sections in a given order, citing an arrangement of the specification as provided in 37 C.F.R. §1.77(b). Applicant has amended the specification to include the corrections and respectfully requests entry of the amendments.

Claim Rejections - 35 U.S.C. § 112

The Office Action states that claims 2, 12, 17-19, 27 and 29 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Office Action states that the claims include indefinite phrases. Without acceding to the correctness of the

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rejection, Applicant has amended the claims to improve the clarity of their recitation of the invention. Entry is respectfully requested. Applicant respectfully submits that the rejection of claims 2, 12, 17-19, 27 and 29 under 35 U.S.C. § 112, second paragraph, is overcome, and respectfully requests that it be reconsidered and withdrawn.

Claim Rejections - 35 U.S.C. § 102

The Office Action states that claims 1-6, 12, 17-18, 21-22 and 30 are rejected under 35 U.S.C. § 102(b) as being anticipated by EP 1306319 (EP '319). In particular, the Office Action states that EP '319 teaches each and every element of the rejected claims. Applicant respectfully traverses the rejection.

The disclosure of cited prior art reference EP '319 is completely silent with respect to the interaction of an inner box and a first inner box holder. That is, there is no teaching in the disclosure that the inner box and the first inner box holder are operable to be coupled or detachably coupled with each other. This limitation is specifically recited in amended claim 1. Accordingly, the cited prior art reference of EP '319 fails to teach all of the claim limitations of claim 1. Claims 2-6, 12, 17-18, 21-22 and 30 depend upon and add further limitations to

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claim 1, and therefore should be allowable for the same reasons as claim 1. Accordingly, Applicant respectfully submits that the rejection of claims 1-6, 12, 17-18, 21-22 and 30 under 35 U.S.C. § 102(b) as anticipated by EP '319 is overcome, and respectfully requests that it be reconsidered and withdrawn.

Claim Rejections - 35 U.S.C. § 103

The Office Action states that claims 15, 19 and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over EP '319 in view of Ramsay et al. (U.S. Patent No. 5,042,674). In particular, the Office Action states that while EP '319 fails to teach an engagement means for stable stacking, the same is taught by Ramsay et al. in an obvious combination. The rejection is respectfully traversed.

As indicated in the Office Action, EP '319 fails to mention the use of engagement means (i.e., toothed provision) to engage the inner box holders onto each other to form a stable stacking. Indeed, the disclosure fails to suggest any difficulty with stacking, and is completely silent as to the subject of stacking or stacking issues. Accordingly, there is no teaching, suggestion or motivation provided by the disclosure by EP '319 to combine the references or modify their teachings to arrive at the invention

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recited in claims 15, 19 and 27. The lack of support for such a combination in the reference teachings indicates that a *prima facie* case of obviousness has not been established based on the content of the disclosures. Indeed, the necessary support for such a conclusion based on the cited references may only be obtained either with improper hindsight reconstruction, where that which the inventor recites is used against him, or with an incorrect standard for obviousness, often referred to as the inappropriate "obvious to try" standard for obviousness. In either case, Applicant respectfully submits that a proper case of *prima facie* obviousness has not been established based on the cited references.

Moreover, claims 15, 19 and 27 depend upon and further limit claim 1, and should be allowable for the same reasons as claim 1, as well as for the additional limitations recited in each dependent claim. Applicant therefore respectfully requests that the rejection of claims 15, 19 and 27 under 35 U.S.C. §103(a) over EP '319 and Ramsay et al. be reconsidered and withdrawn.

The Office Action states that claims 28 and 29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over EP '319 in view of JP 2003-170981 (JP '981). In particular, the Office Action states that while EP '319 fails to teach a circumferential

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projection which engages an edge of the inner box holder, JP '981 teaches the same in an obvious combination. Applicant respectfully traverses the rejection.

The Office Action notes that EP '319 lacks any mention of an inner box with a circumferential projection which engages an edge of the inner box holder. Similarly, JP '981 is completely silent as to a circumferential projection that engages an edge of the first inner box holder. Indeed, JP '981 appears to require that a storing container 2 be freely disposed in a main body 1 of the container. Accordingly, neither of the cited prior art references teach or suggest all the claim limitations recited in claims 28 and 29, either alone or in combination.

Moreover, Applicant notes that claims 28 and 29 ultimately depend upon and further limit claim 1, and should be allowable for all the reasons claim 1 is allowable. Accordingly, Applicant respectfully requests that the rejection of claims 28 and 29 under 35 U.S.C. §103(a) over EP '319 and JP '981 be reconsidered and withdrawn.

Conclusion

In view of the above amendments and discussion, Applicant respectfully submits that the present application is now in

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condition for allowance, and earnestly solicits notice to that effect.

The Examiner is encouraged to telephone the undersigned attorney to discuss any matter that would expedite allowance of the present application.

Respectfully submitted,

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